



126  
774 | Report  
6/10/99  
Cat

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Re application of

Günter BAUR et al. : Group Art Unit: 2871

Serial No.: 08/627,386 : Examiner: K. Parker

Filed: April 4, 1996 :

For: ELECTROOPTICAL LIQUID CRYSTAL SWITCHING ELEMENT

**RESPONSE**

**RECEIVED**

Assistant Commissioner for Patents  
Washington, D.C. 20231

JUN 10 1999

TECHNOLOGY CENTER 2800

SIR:

The following is responsive to the office action of November 30, 1998.

**REMARKS**

A Terminal Disclaimer will be filed shortly and will render moot the double patenting rejection made on pages 6 and 7 of the office action. It appears from the claims not included in the rejections that the terminal disclaimer establishes the allowability of claims 36-45, 63-67, 80, 81, 84-89 and 91-96. As well, from the details of the rejections, it appears that claims 78 and 79 ostensibly are allowable. However, in view of the examiner's comments at page 4, bottom and page 6, first paragraph, of the office action, regarding use of compensators such as birefringent compensators, it appears this might be in error. Clarification is requested.

With respect to the matter of item 3 of the office action, attention is directed to the requirement in claim 20 that  $\alpha_0$  must be equal to or greater than zero degrees versus that of claims 28-32 where  $\alpha_0$  must be greater than zero degrees, i.e., is not equal to zero degrees. It is clear these claim sets are not substantial duplicates of each other.

The examiner's obviousness allegations appear bottomed on two principal contentions. Firstly, it is alleged at the bottom of page 3 and in the penultimate paragraph on page 5 that claim ranges which allegedly overlap those of the prior art are obvious. Whereas this may have been a general belief at one time (see e.g., *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.)), it is clear this is no longer a general principle. See *In re Jones*, 21 USPQ2d 942 (Fed. Cir. 1992). The law currently is that without motivation to modify the prior art in the way necessary to arrive at all the elements of claimed subject matter, there can be no obviousness. In *Jones*, it was recognized by the court that the counterion needed in a claimed herbicide compound was one which those of ordinary skill

240.00 00

06/07/1999 MHAPPY 00000029 04632736

02 FC:126